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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,957	01/15/2002	Klein A. Rodrigues	1991.ALC	5375

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EXAMINER

MRUK, BRIAN P

ART UNIT PAPER NUMBER

1751

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

# Office Action Summary

Application No.

10/047,957

Applicant(s)

RODRIGUES ET AL.

Examiner

Brian P Mruk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 1, 2004 has been entered.

2. This Office action is in response to Applicant's amendment filed December 1, 2004. Applicant has amended claims 1, 4, 10, and 16. Claims 12-15 have been canceled. Currently, claims 1-11 and 16-17 remain pending in the application.

3. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper Nos. 4 and 20040607.

4. The rejection of claims 1-10 and 16-17 under 35 U.S.C. 102(b) as being anticipated by Duccini et al, EP 812,905, is maintained for the reasons of record.

5. The rejection of claims 1-2, 4-11, and 16-17 under 35 U.S.C. 102(b) as being anticipated by Bory et al, U.S. Patent No. 5,747,442, is maintained for the reasons of record.

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6. The rejection of claims 1-2, 4-10, and 16-17 under 35 U.S.C. 102(b) as being anticipated by Kimpton et al, U.S. Patent No. 5,650,473, is maintained for the reasons of record.

## **NEW GROUNDS OF REJECTION**

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-2, 4-9 and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Rodrigues, U.S. Patent No. 6,498,136.

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The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Rodrigues, U.S. Patent No. 6,498,136, discloses a powder detergent composition for removing soils from fabrics, hard surfaces, and dishware (see abstract) comprising a polymer having a hydrophilic backbone, such as acids, amides, ethers, alcohols, aldehydes, ketones, ethylenically unsaturated hydrophilic monomers and esters (see col. 3, lines 15-67) and a hydrophobic moiety, such as siloxane saturated and unsaturated alkyl chains, and nonionic surfactants (see col. 4, lines 22-64), nonionic surfactants (see col. 8, line 57-col. 9, line 40), and builders (see col. 9, lines 41-48), per the requirements of the instant invention. Specifically, note Example 4, which discloses a detergent composition containing the polymers from Examples 2-3, zeolites, nonionic surfactants, and adjunct ingredients, whereby the polymers improve the solubility of the detergent versus detergent compositions without the polymer (see col. 14, lines 46-51). Therefore, instant claims 1-2, 4-9 and 16-17 are anticipated by Rodrigues, U.S. Patent No. 6,498,136.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-2, 4-9 and 16-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S.

Patent No. 6,498,136. Although the conflicting claims are not identical, they are not patentably distinct from each other because Rodrigues, U.S. Patent No. 6,498,136, claims a similar powder detergent composition comprising surfactants, builders, and 0.1-75% by weight of a polymer containing the required hydrophilic backbone and the required hydrophobic moieties (see claims 1-7 of Rodrigues, U.S. Patent No. 6,498,136), that are required by applicant in the instant claims. Therefore, instant claims 1-2, 4-9 and 16-17 are an obvious formulation in view of claims 1-7 of Rodrigues, U.S. Patent No. 6,498,136.

### ***Response to Arguments***

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11. Applicant's arguments filed December 1, 2004 have been fully considered but they are not persuasive.

Applicant argues that Duccini et al, EP 812,905, does not teach or suggest that the hydrophobically modified polymer improves the solubility of a surfactant versus a composition without the polymer. However, the examiner respectfully maintains that this limitation of increased solubility rate is an inherent property of the compositions disclosed in Duccini et al. Specifically, the examiner asserts that applicant has not provided a showing that the polymers disclosed in Duccini et al do not improve the solubility of a surfactant. Furthermore, with respect to applicant's argument that "to invalidate a patent by anticipation, a prior art reference normally needs to disclose each and every limitation of the claim", the examiner asserts that Duccini et al do indeed disclose each and every limitation of the claim, since Duccini et al clearly disclose a detergent composition that contains the required hydrophobically modified polymer, with the required hydrophilic backbone and the required hydrophobic moieties that appear in the limitations of the instant claims.

Applicant further argues that Bory et al, U.S. Patent No. 5,747,442, does not teach or suggest that the hydrophobically modified polymer improves the solubility of a surfactant versus a composition without the polymer. However, the examiner respectfully asserts that this limitation of increased solubility rate is an inherent property of the compositions disclosed in Bory et al. Specifically, the examiner asserts that applicant has not provided a showing that the polymers disclosed in Bory et al do not improve the solubility of a surfactant. It is further argued by applicant that the

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composition disclosed by Bory et al are directed towards a pretreater for fabrics, whereas the instant claims are directed toward compositions for use in the rinse cycle of a dishwasher. However, the examiner respectfully asserts that the preamble of a composition claim is not accorded any patentable weight where it merely recites an intended use of the composition. **See MPEP 2111.02**. Therefore, the examiner maintains that the instant claims are anticipated by Bory et al, since Bory et al clearly teach compositions that contain all of the required components recited in the instant claims.

Applicant further argues that Kimpton et al, U.S. Patent No. 5,650,473, does not teach or suggest that the hydrophobically modified polymer improves the solubility of a surfactant versus a composition without the polymer. However, the examiner respectfully asserts that this limitation of increased solubility rate is an inherent property of the compositions disclosed in Kimpton et al. Specifically, the examiner asserts that applicant has not provided a showing that the polymers disclosed in Kimpton et al do not improve the solubility of a surfactant.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (571) 272-1316. The fax phone



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number for the organization where this application or proceeding is assigned is (703)  
872-9306.

*BPM*

Brian Mruk  
February 16, 2005

*Brian P. Mruk*

Brian P. Mruk  
Primary Examiner  
Tech Center 1700